REMARKS

Claims 16, 21 and 24-30 stand newly rejected under 35 U.S.C. 103(a) as being unpatentable over patent No. WO 01/20855 (hereinafter Etsuo) in view of US patent No. 6,434,601 (hereinafter Rollins). Claim 23 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Etsuo in view of Rollins and further in view of JP 11232188 (hereinafter Yoshihiro). Applicant respectfully requests reconsideration of the rejections, and further requests allowance of the pending claims in view of the foregoing amendments and the following remarks.

M.P.E.P. 2143.04 provides that to establish *prima facie* obviousness of a claimed invention, all the claims limitations must be taught or suggested by the prior art. All words in a claim must be considered for judging the patentability of the claim against the prior art. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending there from is nonobvious.

Claim 16 is directed to a method for transmituing messages in a network via data terminals connected thereto. For the convenience of the reader, the reference numerals below refer to FIGs. 1 and 2 of the drawings of the present invention. A message 14 to be relayed is sent from a sender data terminal to a first mail processing device 2 assigned to the sender data terminal. A unique identifier is assigned to the message that indicates that a message to be relayed is on the sender data terminal or in the first mail processing device. The identifier comprises a plurality of subidentifiers, each of which is assigned to at least one message element contained in a relayed message. A test message 6 including the subidentifiers is sent from the first mail processing device 2 to a second mail processing device 4 assigned to a recipient address data terminal. The second mail processing device 4 evaluates the test message 6 sent by the first mail processing device 2. The evaluating is configured to process each subidentifier in the test message relative to data present in the second mail processing device indicative of respective message elements previously relayed to the recipient address data terminal. An evaluation-result of the test message 7 is sent from the second mail processing device 4 to the first mail processing device 2. The evaluation-result of the test message 7 indicates to the first mail processing device 2 to transmit message elements or to block message elements from being transmitted to the second mail processing device. More particularly, the "transmitting or blocking of respective ones of the message elements in response to the evaluation-result of the test message is configured to suppress a duplicative reception by the recipient address data terminal of a message element present in a message previously received by the recipient address, and is further configured to ensure that an amended message element of a message element present in the previously received message is

transmitted to the recipient address". See at least paragraphs 0006 through 0008 of the US patent application publication of the present invention. Message elements transmitted from the first mail processing device 2 to the second mail processing device 4 are relayed to the recipient address data terminal respective.

It is respectfully submitted that neither Etsuo nor Rollins, singly and in combination, teach or suggest each of the structural and/or operational relationships of the claimed invention. The Office Communication correctly acknowledges that Etsuo fails to describe or suggest each of the structural and/or operational relationships of the claimed invention. The Office Communication then applies Rollins in an attempt to correct the deficiencies of Etsuo regarding the claimed invention.

As described by Rollins, "the invention [of Rollins] seeks to prevent the delivery of an e-mail message having an incorrect user name, server name, or a misspelling in either or both in the addressee's Internet e-mail address. If an error is detected, it is called to the sender's attention, where it may be corrected before the message is sent. confirming the existence, or non-existence, of the named addressee by the time the message is completed and ready for transmission by the user". See Abstract of Rollins. In accordance with the objectives of Rollins, the disclosure of Rollins describes at col. 4, line 41 *et. seq.*, a test message for confirming the existence, or non-existence, of the named addressee by the time the message is completed and ready for transmission by the user.

One skilled in the art will appreciate that the objective of Rollins (confirming the existence of the named addressee and/or correcting the spelling of a user's name and/or the spelling of a server's name) has virtually nothing to do with structural and/or operational relationships where "transmitting or blocking of respective ones of the message elements in response to the evaluation-result of the test message is configured to suppress a duplicative reception by the recipient address data terminal of a message element present in a message previously received by the recipient address, and is further configured to ensure that an amended message element of a message element present in the previously received message is transmitted to the recipient address", as set forth in the amended claims.

Furthermore, the Applicant argues that the combination of references used by the Examiner is not appropriate with connection to the claimed invention. The Office Communication states "that the suggestion/motivation of the combination [of Etsuo and Rollins] would have been to prevent delivery of an e-mail message having an incorrect user name, server name or misspellings in either or both in the addressee's Internet E-mail address and calls the addressing errors to he(sic) sender's attention, where it may be corrected before the message is sent . . ." The foregoing statement may well be an

accurate description of the objectives of Rollins. However, the objectives of Rollins have little to do with either the claimed invention and/or the applied primary reference (Etsuo). The Office Action nowhere articulates how the stated object of Etsuo (e.g., avoiding sending duplicate E-mails), would be satisfactorily carried out by combining with Rollins, which is directed to solving a very different problem. Accordingly, it is respectfully submitted that under this alternative basis of traversal, the Examiner has not followed applicable M.P.E.P. requirements for establishing an appropriate suggestion or motivation to make the proposed modification. Consequently, under either basis of traversal, the §103 rejection over Etsuo and Rollins should be withdrawn and allowance of claim 16 (and claims depending there from) are solicited.

In connection with dependent claim 23, it is respectfully noted that Yoshihiro fails to remedy the fundamental deficiencies of the Etsuo/Rollins combination. Consequently, this claim is also allowable over the applied art.

Independent claim 28 is directed to a network and, in view of the discussion above, it is respectfully submitted that claim 28 is also patentable over Etsuo and Rollins and allowance of claim 28 (and claims depending there from) is similarly requested.

Conclusion

It is respectfully submitted that each of the claims pending in this application recites patentable subject matter and it is further submitted that such claims comply with all statutory requirements and thus each of such claims should be allowed.

The undersigned represents under 37 C.F.R. 1.34 that he is duly authorized to file this response.

Respectfully submitted,

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By: _____

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